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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,774

06/19/2006

Joachim Zimmerman

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LAMBERT & ASSOCIATES, P.L.L.C.
92 STATE STREET
BOSTON, MA 02109-2004

EXAMINER

HOPKINS, CHRISTINE D

ART UNIT

PAPER NUMBER

3735

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,774	Applicant(s) ZIMMERMAN, JOACHIM	
	Examiner CHRISTINE D. HOPKINS	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Appeal Brief filed 14 April 2008. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Claim 1 is now pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rings "arranged in adjacent rows in opposite alignment" must be shown or the feature(s) canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification of the instant application fails to describe how a pulsating magnetic field is generated by the magnetized or magnetizable balls or rings. Moreover, the specification is not enabling with respect to how the rings are arranged in “adjacent rows” given that the drawings lack rows.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what defines an “attractive alignment” or “opposite alignment” as recited at lines 8 and 10, respectively. For instance, the

limitations may be interpreted to be "attractive" for aesthetic purposes and "opposite" meaning each magnetized element is located in the ring opposite to another.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 1 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. At line 8, the claim recites "magnetized or magnetizable balls" arranged in a tube to form a ring. Such features would not produce any effect such that a therapeutic benefit would be induced upon a subject. Furthermore, pulsating magnetic field therapy relies upon the use of a coil and signal generator in order to produce a therapeutic magnetic field. The claim is silent with respect to these features.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ansari (U.S. Patent No. 3,805,777). Ansari teaches an intrauterine device comprising a ring

embedded with magnets. Regarding claim 1, Ansari discloses a device **10**, in the form of a ring, also made of an inert, elastically deformable material. Magnetic rings segments, or “magnetized balls,” **18**, capable of radiating a pulsating magnetic field, are introduced into the ring **10** and are arranged in opposite alignment (col. 3, lines 26-45 and Figs. 1-2). The segments are interpreted as balls based on the evidence provided by the figures of a roundish body. The device is capable of being placed within the vagina or uterine cavity (col. 3, lines 53-55).

Response to Arguments

11. Applicant’s arguments filed in the Appeal Brief on 14 April 2008 with respect to the objection to the specification have been fully considered and are persuasive. The objection to the specification has been withdrawn.

12. Applicant’s arguments filed in the Appeal Brief on 14 April 2008 with respect to the rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, have been fully considered and are persuasive. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, has been withdrawn. However, a new rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, has been made, see rejection *supra*.

13. Applicant’s arguments filed in the Appeal Brief on 14 April 2008 with respect to the rejection of claim 1 under 35 U.S.C. 102(b) citing Ansari (‘777) have been fully

Art Unit: 3735

considered and are not persuasive. Applicant contends that Ansari does not teach a medical apparatus for the treatment of living beings which incorporates magnetic field therapy that allows for a pulsating magnetic field. However, this argument is not persuasive. The invention of Ansari is fully capable of allowing a pulsating magnetic field in that it incorporates magnetic ring segments which are capable of being acted upon to emit a pulsating magnetic field. It is further noted that the claim language recites that “magnetized” or “magnetisable” balls or rings are introduced into an inert tube. However, a “magnetisable” ball could be, for instance, a metal component which in itself does not emit a pulsating field, rather is acted upon by an external generating source to cause the emission of a pulsating magnetic field.

Applicant also contends that the instant invention is directed to providing relief to women for hypogastrium complaints and various other pains and to men for prostate complaints and that Ansari fails to provide these features. However, it is noted that the features upon which applicant relies (i.e., hypogastrium and prostate complaints) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further contends that the device of Ansari is only an intrauterine device that contains magnetic elements solely for the purpose of inserting and removing the device from the uterine cavity and that the instant invention is used for the therapy of painful conditions. However, this argument is not persuasive. Regardless of the intended use, Ansari is applied as a rejection under 35 U.S.C. 102(b) and further anticipates each and every claim limitation. As noted above, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further contends that Ansari does not disclose balls arranged in an attractive alignment or rings arranged in the tube in opposite alignment. However, this argument is not persuasive. Applicant notes that an “attractive alignment” produces a calming, harmonizing effect, as noted in the specification. The Examiner has interpreted this to mean an alignment which is aesthetically pleasing to a user. Thus, Ansari is believed to anticipate this limitation since its “magnetized or magnetizable balls” are featured in the same alignment as that of the instant invention (see Fig. 2 of Ansari). Furthermore, the claim recites “magnetized or magnetizable rings” arranged “in adjacent rows in opposite alignment.” It is difficult to ascertain the meaning of such limitations since the drawings fail to show the rings “in adjacent rows in opposite alignment.” Therefore, the claims have been given their broadest, reasonable

interpretation. In view of the foregoing, the rejection of claim 1 under 35 U.S.C. 102(b) citing Ansari ('777) has been maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE D. HOPKINS whose telephone number is (571)272-9058. The examiner can normally be reached on Monday-Friday, 7 a.m.-3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information

Art Unit: 3735

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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